

LUD 5256.4 (09903230)**CERTIFICATE OF FACSIMILE TRANSMISSION**

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DEC 01 2005**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Applicant : Hiles, et al.
Serial No. : 09/325,095
Filed : June 3, 1999
For : METHODS FOR DETERMINING EXPRESSION OF A P13
KINASE GENE
Art Unit : 1645
Examiner : J. Hines

December 1, 2005

Commissioner for Patents
P.O. Box 1450
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**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF
(37 CFR 41.37)**

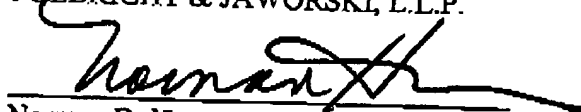
Responsive to the Notification of Non-compliant Appeal Brief mailed November 22, 2005 (copy enclosed), applicants submitted a Substitute Brief on Appeal (37 CFR §41.37(c)), together with a Transmittal Letter dated November 17, 2005 by Express Mail.

LUD 5256.4 (09903230)

Enclosed is a copy of the Express Mail Receipt and the return postcard from the USPTO, acknowledging receipt.

Respectfully submitted,



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CASE NO LUD-5256.4 (909903230) (NDH) Serial No: 09/325,095

Date Mailed: 11/17/05 Due Date:

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Express Mail No: EV 331565439 US

Transmittal Letter

Substitute Brief on Appeal (37 CFR §41.37(c))

Claims Appendix

Evidence Appendix

Related Proceedings Appendix





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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 09/325,095 | 06/03/1999 | IAN D. HILES | LUD5246.4JEL | 2392 |
| 24972 | 7590 | 11/22/2005 | | |
| FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198 | | | EXAMINER HINES, JANA A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1643 | |

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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FULBRIGHT & JAWORSKI, LLP
NEW YORK OFFICE

**Notification of Non-Compliant Appeal Brief
(37 CFR 41.37)**

Application No.

09/325,095

Applicant(s)

HILES ET AL

Examiner

Ja-Na Hines

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on December 22, 2004 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☒ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☒ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☒ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

The appeal brief filed December 22, 2004 does not comply with the new rules under 37 CFR section 41.37(c). It is required that a substitute brief be submitted that is in compliance with that section. For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at: <http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation Sheet (PTOL-462)

Application No.